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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,855	09/14/2005	Hidechika Okada	3348/1	7847

23638 7590 01/09/2008  
ADAMS INTELLECTUAL PROPERTY LAW, P.A.  
Suite 2350 Charlotte Plaza  
201 South College Street  
CHARLOTTE, NC 28244

EXAMINER

PARKIN, JEFFREY S

ART UNIT	PAPER NUMBER
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1648

MAIL DATE	DELIVERY MODE
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01/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/519,855

Applicant(s)

OKADA ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Notice to comply...

Serial No.: 10/519,855  
Applicants: Okada, H., et al.

Docket No.: 3348/1  
Filing Date: 09/14/2005

### **Detailed Office Action**

#### **Status of the Claims**

Claims 1-7 are pending in the instant application.

#### **37 C.F.R. § 1.821-1.825**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2) (e.g., see pages 23-25 and 28 of the specification). However, this application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825 for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicants are reminded that sequences appearing in the specification and/or **drawings** (e.g., see Figure 3(?)) must be identified by a sequence identifier (SEQ ID NO.:) in accordance with 37 C.F.R. § 1.821(d). Applicant must provide appropriate amendments to the specification and/or drawings inserting the required sequence identifiers. Extensive amendments may necessitate the submission of a substitute specification. The specification is objected to because it fails to meet the requirements set forth *supra*.

#### **Specification**

Applicants are reminded of the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use. Arrangement of the Specification as provided in 37 C.F.R. § 1.77(b), **the**

specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 C.F.R. § 1.97 and § 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING. (See M.P.E..P § 2424 and 37 C.F.R. § 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 C.F.R. § 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc.)

The disclosure fails to contain the requisite section headers in the prescribed order. Moreover, **the disclosure references five figures, yet there only appear to be three figures in the application** (see pages four and five). The brief description of the drawings is also inadequate because it fails to clearly set forth the various parameters of the experimental data set forth in each drawing (i.e., what values are represented by the ordinate and abscissa). Finally, **the disclosure references two tables but fails to include them** (see pages 7 and 12). Appropriate correction is required. Extensive amendments may necessitate the submission of a substitute specification. A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strikethrough except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### **Drawings**

The drawings are objected to because they fail to include the appropriate figure designation. Corrected drawing sheets in compliance with 37 C.F.R. § 1.121(d) are required in reply to

the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 C.F.R. § 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**35 U.S.C. § 112, Second Paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Two separate requirements are set forth under this statute: (1) the claims must set forth the

subject matter that applicants regard as their invention; and (2) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. Concerning claims 1, 2, and 6, the reference to a Mab that specifically recognizes HIV-infected cells to induce apoptosis to the cells is vague and indefinite. The salient characteristics of the claimed composition are not readily manifest. Applicants should clearly and unambiguously identify the functional characteristics of the claimed antibody (i.e., A monoclonal antibody that binds specifically to HIV-1-infected cells and is capable of inducing HIV-1-infected cells to undergo apoptosis).

**35 U.S.C. § 112, First Paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

*Biological Deposit Requirement*

Claims 4-7 are rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure for the claimed invention. Claims 4 and 5 recite only partial variable regions for Mab 2G9. Since the variable and constant regions of both the heavy and light chains are required for antigen binding, disclosure of one chain is insufficient. Applicants need to reference the hybridoma in the claim language or provide the complete nucleotide sequence of both chains. Claims 5 and 6

reference a hybridoma. It is noted that it has been deposited. However, simply depositing the hybridoma is insufficient to meet the deposit requirements. Applicants also need to provide a statement specifying that the the deposit has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements.

It is apparent that the monoclonal antibodies, as well as, the hybridoma cell line, are required to practice the claimed invention. As required elements, they must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If they are not so obtainable or available, the enablement requirements of 35 U.S.C. § .112, first paragraph, may be satisfied by a deposit of the hybridoma cell lines producing said antibodies. See 37 C.F.R. § 1.802.

Due to the unpredictability associated with antibody production (i.e., each antibody generally has a unique structure) and the failure of the specification to provide any detailed structural information concerning the claimed antibodies, and 108-394 do not appear to be readily available materials.<sup>1</sup> Deposit of the hybridoma cell lines producing said antibodies or detailed structural information (i.e., the complete nucleotide or amino acid sequence of each antibody) would satisfy the enablement requirements of 35 U.S.C. § .112.

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<sup>1</sup> It has been well-documented that most animals are capable of producing a vast repertoire of structurally and functionally distinct antibodies. For instance, conservative estimates suggest that humans are capable of producing over 32 million different combinations of light and heavy chains. This estimate excludes various other sources of diversity. See "Immunoglobulins: Molecular Genetics", in *Fundamental Immunology, Fourth Edition*, W. E. Paul, ed., Lippincott-Raven Publishers, Philadelphia, 1999, pp. 142-143.



If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty **and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements.** See 37 C.F.R. § 1.808.

If the deposits have not been made under the provisions of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made at an acceptable depository and that the following criteria have been met:

(a) during the pendency of the application, access to the deposits will be afforded to one determined by the Commissioner to be entitled thereto;

(b) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent;

(c) the deposits will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;

(d) a viability statement in accordance with the provisions of 37 C.F.R. § 1.807; and

(e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

In addition, the identifying information set forth in 37 C.F.R. § 1.809(d) should be added to the specification. See 37 C.F.R. § 1.803-1.809 for additional explanation of these requirements.

*Written Description*

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *In re Rochester*, 358 F.3d 916, 69 U.S.P.Q.2d 1886 (C.A.F.C. 2004). The claims are broadly directed toward any IgM monoclonal antibody (Mab) that recognizes HIV-infected cells and is capable of inducing apoptosis in said cells. The disclosure provides a single Mab (2G9) and attendant hybridoma cell line (BP-8378). No other Mabs or cell lines are disclosed in the specification.

The crux of the statutory requirement governing written description is whether one skilled in the art, familiar with the practice of the art at the time of the filing date, could reasonably have found the later claimed invention in the specification as filed. *In re Kaslow*, 707 F.2d 1366, 1375, 217

U.S.P.Q. 1089, 1096 (Fed. Cir. 1983). *In re Wilder*, 736 F.2d 1516, 1520 222 U.S.P.Q. 349, 372 (Fed. Cir. 1984, cert. denied, 469 U.S. 1209 (1985)). *Texas Instruments, Inc. v. International Trade Comm'n*, 871 F.2d 1054, 1063, 10 U.S.P.Q.2d 1257, 1263 (Fed. Cir. 1989). Moreover, the courts have stated that the evaluation of written description is highly fact-specific, and that broadly articulated rules are inappropriate. *In re Wertheim*, 541 F.2d 257, 263, 191 U.S.P.Q. 90, 97 (C.C.P.A. 1976). *In re Driscoll*, 562 F.2d 1245, 1250, 195 U.S.P.Q. 434, 438 (C.C.P.A. 1977). It is also important to remember that the true issue in question is not whether the specification enables one of ordinary skill in the art to make the later claimed invention, but whether or not the disclosure is sufficiently clear that those skilled in the art will conclude that the applicant made the invention having the specific claim limitations. *Martin v. Mayer*, 823 F.2d 500, 505, 3 U.S.P.Q.2d 1333, 1337 (Fed. Cir. 1987).

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor has **possession** of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described

or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1996).

The skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention for the following reasons. First, the claims are extremely broad and fail to recite any meaningful structural information. The Mabs are not limited to a specific amino acid sequence or binding specificity. Second, the disclosure fails to provide any guidance pertaining to the epitope recognized by Mab 2G9. Thus, it is not readily manifest if the Mab recognizes a viral or cellular determinant. Third, the specification only provides a single Mab that meets the claimed limitations. However, the claims are not limited to any particular Mab or binding specificity. Therefore, absent a more detailed description pertaining the binding specificity of the Mabs of interest and detailed sequence analysis of said Mabs, the skilled artisan would reasonably conclude that applicants were not in possession of the claimed invention at the time of filing.

*Scope of Enablement*

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not reasonably enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The claims are broadly directed toward any IgM monoclonal antibody (Mab) that recognizes HIV-infected cells and is capable of inducing apoptosis in said cells. The disclosure only details the preparation of a single hybridoma cell line and Mab.

The legal considerations that govern enablement determinations pertaining to undue experimentation have been clearly set forth. *Enzo Biochem, Inc.*, 52 U.S.P.Q.2d 1129 (C.A.F.C. 1999). *In re Wands*, 8 U.S.P.Q.2d 1400 (C.A.F.C. 1988). *Ex parte Forman* 230 U.S.P.Q. 546 (PTO Bd. Pat. App. Int., 1986). The courts concluded that several factual inquiries should be considered when making such assessments including the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims. *In re Rainer*, 52 C.C.P.A. 1593, 347 F.2d 574, 146 U.S.P.Q. 218 (1965). The disclosure fails to provide adequate guidance pertaining to a number of these considerations as follows:

- 1) The claims are extremely broad and do not provide any significant structural limitations. The Mabs are not limited to a specific amino acid sequence or binding specificity.
- 2) The disclosure fails to provide adequate guidance pertaining to the binding specificity of the claimed Mabs. Which antigen

and epitopes are recognized? Are they viral or cellular determinants?

3) The disclosure fails to provide adequate guidance pertaining to the structural information of the class of antibodies.

4) It is not readily manifest if a reproducible method is available for producing said Mabs because only one was generated.

5) The disclosure fails to provide an adequate number of working embodiments. Only one Mab was identified.

When all the aforementioned factors are considered *in toto*, it would clearly require undue experimentation to practice the claimed invention in a manner commensurate in scope with the claims.

#### *Enablement*

Claims 2-5 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are broadly directed toward pharmaceutical compositions comprising an IgM monoclonal antibody (Mab) that recognizes HIV-infected cells and is capable of inducing apoptosis in said cells and capable of treating or preventing HIV infection and the onset of AIDS.

The legal considerations that govern enablement determinations pertaining to undue experimentation have been clearly set forth. *Enzo Biochem, Inc.*, 52 U.S.P.Q.2d 1129 (C.A.F.C. 1999). *In re Wands*, 8 U.S.P.Q.2d 1400 (C.A.F.C. 1988). *Ex parte Forman* 230 U.S.P.Q. 546 (PTO Bd. Pat. App.

Int., 1986). The courts concluded that several factual inquiries should be considered when making such assessments including the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art and the breadth of the claims. *In re Rainer*, 52 C.C.P.A. 1593, 347 F.2d 574, 146 U.S.P.Q. 218 (1965). The disclosure fails to provide adequate guidance pertaining to a number of these considerations as follows:

Problems:

- 1) The claims are extremely broad and do not provide any significant structural limitations. The Mabs are not limited to a specific amino acid sequence or binding specificity.
- 2) The disclosure fails to provide adequate guidance pertaining to the binding specificity of the claimed Mabs. Which antigen and epitopes are recognized? Are they viral or cellular determinants?
- 3) The disclosure fails to provide adequate guidance pertaining to the structural information of the class of antibodies.
- 4) It is not readily manifest if a reproducible method is available for producing said Mabs because only one was generated.
- 5) The disclosure fails to provide an adequate number of working embodiments. Only one Mab was identified. Moreover, the only data provided was obtained using *in vitro* inhibition studies which are not representative of *in vivo* or clinical efficacy. Moreover, no data was provided from a suitable animal model or preliminary clinical trials.

6) The state-of-the-art as it pertains to the generation of Mabs with the recited characteristic is quite unpredictable. The generation of anti-HIV immunotherapeutics is difficult. Moreover, the claimed Mabs only induce apoptosis in ~20% of the cell population. This means that ~80% of the cell population is still infected and capable of producing virus. Thus, it does appear that this would have any meaningful clinical effect.

When all the aforementioned factors are considered *in toto*, it would clearly require undue experimentation to practice the claimed invention.

### **Correspondence**

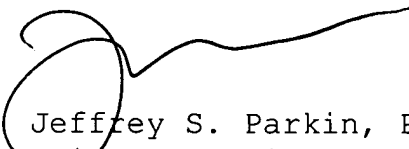
Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce R. Campell, Ph.D., can be reached at (571) 272-0974. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Applicants are reminded that the United States Patent and Trademark Office (Office) requires most patent related correspondence to be: a) faxed to the Central FAX number (571-273-8300) (updated as of July 15, 2005), b) hand carried or delivered to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), c) mailed to the mailing address set forth in 37 C.F.R. § 1.1 (e.g., P.O. Box 1450, Alexandria, VA 22313-1450), or d) transmitted to the Office using the Office's Electronic Filing System. This notice replaces all prior Office notices specifying a specific fax number or hand carry address for certain patent related correspondence. For further information refer to the Updated Notice of Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence, and Exceptions Thereto, 1292 Off. Gaz. Pat. Office 186 (March 29, 2005).



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,



Jeffrey S. Parkin, Ph.D.  
Primary Examiner  
Art Unit 1648

05 January, 2008

<b>Notice to Comply</b>	<b>Application No.</b> 10/519,855	<b>Applicant(s)</b> Okada, H., <i>et al.</i>	
	<b>Examiner</b> Jeffrey S. Parkin	<b>Art Unit</b> 1648	<b>Paper No.</b> 01/05/2008

# **NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: Applicants are reminded that sequences appearing in the specification and/or **drawings** (e.g., see Fig. 3(?)) must be identified by a sequence identifier (SEQ ID NO.:) in accordance with 37 C.F.R. 1.821(d). Sequence identifiers for sequences appearing in the drawings may appear in the Brief Description of the Drawings. Applicant must provide appropriate amendments to the specification and/or drawings inserting the required sequence identifiers. Extensive amendments may necessitate the submission of a substitute specification and drawings.

## **Applicant May Need to Provide:**

- ☒ An substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (571) 272-0951
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